

REMARKS

Claims 1-26, 28-36, 38, 39, 41-46, 48-54, and 56-62 are pending. Claims 59-62 are amended. No new matter has been added by virtue of the amendment, support being found throughout the specification as filed.

1. 35 U.S.C. § 103 Rejections

Claims 1-14, 16-25, 29-34, 38, 39, 46, 48-54, and 58-61 are rejected under 35 U.S.C. § 1023(a) over U.S. Patent No. 6,786,896 to Madhani and U.S. Patent No. 5,695,500 to Taylor. Applicants respectfully traverse.

Applicants' independent claim 1 recites an apparatus for placing a proximal portion of a needle in a target area. The apparatus includes a first arm being configured and arranged to rotatably support a distal portion of the needle about its translational axis. The apparatus further includes a second arm spaced apart from the first arm and being configured and arranged to support a proximal portion of the needle. As set out, the second arm is aligned with the first arm so that the first arm and distal portion of the needle are movable toward the second arm. Applicants' independent claims 16, 29, and 46 also recite a device and methods wherein a first arm is configured and arranged to rotatably support a distal portion of a needle about its translational axis, and a second arm spaced apart from the first arm and being configured and arranged to support a proximal portion of the needle.

The Office asserts that Madhani discloses a first arm (304 or 1m1) that supports a penetrating member (312), and a "second arm (1m1') spaced from the first arm and arranged to support a portion of the needle" (penetrating member 312).

Applicants respectfully disagree with the Office's comparison of Madhani's element 312 with Applicants' claimed needle. Madhani's describes a shaft 312 having "an end effector 314 consisting of a wrist 316 and grippers 318" at its distal end (col. 10, lines 50-54). Clearly, the shaft 312 is not a needle. Rather, Madhani's shaft 312 and end effector 314 are very different structural elements specifically provided and configured so as to provide the device with the capability to grasp an object while providing a plurality of degrees of freedom. Further, Madhani's device could not be modified such that the shaft 312 with the end effector 314 is

replaced with a needle because this would eliminate the degrees-of-freedom and, thus, would impermissibly change the principal of operation of Madhani. See *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); MPEP §2143.01. At best, Madhani's grippers (which are located at the distal end of the shaft 312) may grasp a needle. In the event that grippers grasp a needle, the needle is grasped at one location along the length of the needle. Clearly, nowhere does Madhani describe or suggest a device comprising a first arm that supports a distal portion of a needle and a second arm that supports a proximal portion of a needle, as recited in Applicants' claims.

Taylor does not remedy these deficiencies. The Office asserts that Taylor "teaches a needle arranged to rotate about translational axis of the needle (see fig. 9, element 241)." However, like Madhani, nowhere does Taylor teach or suggest a first arm configured and arranged to rotatably support a distal portion of a needle about its translational axis, and a second arm spaced apart from the first arm and being configured and arranged to support a proximal portion of the needle, wherein the second arm is aligned with the first arm so that the first arm and distal portion of the needle are movable toward the second arm. Rather, Taylor describes a manipulator 240 that supports an instrument 241 at one single location along the instruments' length and provides for various degrees of rotational freedom (see, e.g., fig. 9 and col. 18, lines 52-09).

Thus, claims 1, 16, 29, and 46, and all claims dependent therefrom, are patentable over Madhani and Taylor. Reconsideration of the rejections is respectfully requested.

2. Allowable Subject Matter

Applicants appreciate the notification in the Office Action of allowable subject matter, i.e. that claims 26, 28, 41-45, 51, 56, and 57 are allowed and that claims 15, 35, 36, and 62 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

CONCLUSION

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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